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| 09/479,999      | 01/10/2000  | LEE EVEN NAKAMURA    | A7631/ST9-97        | 3788             |

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SUGHRUE MION ZINN MACPEAK & SEAS PLLC  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 200373202

EXAMINER

HUYNH, CONG LAC T

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/479,999

Applicant(s)

NAKAMURA ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: request for reconsideration filed 7/25/02 of application filed on 01/10/00 which is a continuation of the application 08/892,842 filed on 7/11/97, now US Pat No. 6,178,433 B1.
2. Claims 7-12, 27-31 are pending in the case. Claims 7, 11 and 27 are the independent claims.
3. The rejections of claims 7-12, 27-31 under 35 U.S.C. 103(a) as being unpatentable over Brown have been withdrawn in view of Applicants' argument.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7-12, 27-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of

Art Unit: 2178

U.S. Patent No. 6,178,433 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

'433 discloses:

- generating a page of presentation material in response to a request for said first information, wherein the page is generated based on the first presentation layout, and the first information and the second information are included in a single web page (claims 1-5, 10, 12, 14-15)
- the first variables and the second variables corresponding to the first information and the second information and also for the first and second presentation layouts (claim 9, the first and second presentation materials are dynamically generated by interpreting the macros having *the first and second variables* containing data for generating the first and second presentation materials; claim 13, building the presentation page by interpreting a macro containing the variables; claim 16)
- said page is a www page for display on a web browser (claims 2, 4)
- said browser does not support a hypertext markup language frame tag (claims 11)

'433 does not disclose:

- defining, in a first portion of the file, a first variable equal to first information and a second variable equal to second information
- defining, in a second portion of the file, first and second presentation layouts, wherein said first presentation layout includes said first variable and said second presentation layout includes said second variable

Art Unit: 2178

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified '433 to include "defining ... a first variable... and a second variable..." and "defining ... first and second presentation layouts ..." for the following reasons. The fact that '433 provides interpreting the macros having the first and second variables containing data for generating the first and second presentation materials suggests that the first variable and the second variables be defined for the correspondent first and second data for presentations.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-12, 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, *Using Netscape 2, Que Corporation*, pages 8-11, 163, 675-679, 779 in view of Benedikt et al. (US Pat No. 5,966,535, 10/12/99, filed 12/7/95).

Regarding independent claim 7, Brown discloses:

- generating a page of presentation material in response to a request for an information, wherein the page is generated based on the first information

layout and includes the first information and does not contain the second information (page 10, figure 1.4, when a user selects NFL from the list of items on the left side and, only the information about NFL is displayed on the right side of the page; the information of Cyberspace Showdown III or Raiders' Fan Wins Contest! are not shown; figure 7.15, in response to a request for an information, which is a link, on the list of people displayed on the left side, and only the resume of the selected person Doug Folsom is displayed on the right side, the resume of Carol Guttery is not shown on the right side)

Brown does not disclose defining in a single file a first variable and a second variable for a first information and a second information, and defining in a single file a presentation layout for each said information corresponding to the variables.

Benedikt discloses defining variables in the HTML code of a web document for different data (col 8, lines 27-44; col 11, lines 2-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Benedikt into Brown for defining variables for data in a web page and referring said variables to the activities related to said data because of the following reason. Brown shows the ability of displaying in response to a request for an information based on the first information layout and includes the first information and does not contain the second information, and Benedikt has the ability of defining variables in HTML tags. Since it was well known in the art that a HTML tag includes instructions that tell web browser how

Art Unit: 2178

to present a web document, the fact that Brown has the ability of displaying the first information upon a request in the presentation layout where the presentation layout does not contain the second information suggests that the tags in the HTML code of the web document include such variable definition as well as referring the variables to the corresponding presentation layout to obtain the result as disclosed in Brown. Also, *the list on the left side as disclosed is considered as the topic outline of the web page*, and the information displayed on the right side of the web page is based on the user's selection from said list (page 163, figure 7.15). This suggests that all data selected from the list be included in a single file.

Regarding claims 8 and 10, which are dependent on claim 7, Brown discloses that said page is World Web page for displaying on the web browser and the request, which is actually a hyperlink, includes a uniform resource locator URL (page 10, figure 1.4; page 163, figure 7.15).

Regarding claim 9, which are dependent on claim 7, Brown discloses that the web browser does not support a hypertext markup language frame tag (page 10, figure 1.4; page 779, apply NOFRAMES for no frames-capable browsers).

Claims 11-12 are for a system of method claims 7-10, and are rejected under the same rationale.

Art Unit: 2178

Claims 27-31 are for a system of method claims 7-10, and are rejected under the same rationale.

***Response to Arguments***

8. Applicant's arguments with respect to claims 7-12, 27-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Brown fails to teach or suggest "defining, in the first portion of the single file, a first variable equal to first information and a second variable equal to second information" and "defining, in a second portion of the single file, first and second presentation layouts, wherein said first presentation layout includes said first variable and said second presentation layout includes said second variable."

Examiner agrees.

However, Brown teaches generating a page in response to a request for said first information, wherein the page is generated based on the first presentation layout and includes said first information and does not contain said second information (page 163, figure 7.15). As seen in the figure 7.15, the left portion of the web page is a list of resume links where the list is considered as the outline of the web page. When a user clicks on the first resume link, the first resume will be displayed on the right portion of the web page and only the first resume is displayed, not the second resume. This suggests that the first variable equal to



Art Unit: 2178

first information and the second variable equal to the second information be defined in the first portion, which is the left portion of the web page, and the first and second presentation layouts are defined in the right portion of the web page. Benedikt, in combination with Brown, discloses defining variables in the hyperlink tags for referring data (col 8, lines 27-43; col 11, lines 2-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Benedikt into Brown for defining variables for corresponding data in a web page and referring said variables to the activities related to said data because of the following reason. Brown shows the ability of displaying in response to a request for an information based on the first information layout and includes the first information and does not contain the second information, and Benedikt has the ability of defining variables in HTML tags. Since it was well known in the art that the HTML tags include instructions that tell web browser how to present a web document, the fact that Brown has the ability of displaying the first information upon a request in the presentation layout where the presentation layout does not contain the second information suggests that the tags in the HTML code of the web document includes such variable definition as well as using the variables for referring data to the corresponding presentation layout to obtain the presentation as disclosed in Brown.

Applicants argue that since there is no underlying HTML code for the display of figure 7.15, there is no way of knowing whether the first and second presentation

Art Unit: 2178

layout are defined in a single file, which also defines the first variable and the second variable.

Examiner agrees.

However, as mentioned above Benedikt discloses defining variables for data in the HTML tags of *a web document* (col 8, lines 27-44; col 11, lines 2-15). Brown shows the ability of displaying in response to a request for an information based on the first information layout and includes the first information and does not contain the second information. Since it was well known in the art that a HTML tag includes instructions that tell web browser how to present a web document, the fact that Brown has the ability of presenting the first information upon a request in the presentation layout where the presentation layout does not contain the second information suggests that the tags in the HTML code of the web document include such variable definition as well as including the variables to the corresponding presentation layouts to obtain the corresponding presentation upon the user's selection as disclosed in Brown. Also, *the list on the left side as disclosed is considered as the outline of the web page*, and the information displayed on the right side of the web page is based on the user's selection from said list (page 163, figure 7.15). This suggests that all data selected from the list be included in a single file.

Applicants argue that Examiner alleged that the "Cyberspace Showdown III" and "Raider's Fan Wins Contest" (in Brown, page 10, figure 1.4,) are hyperlinks since

Art Unit: 2178

Examiner's interpretation is merely a speculation without inspection of the underlying HTML code that defines the hyperlinks. Applicants further argue that reliance on a static image without the ability to inspect the underlying HTML code does not provide sufficient grounds to render the claimed invention unpatentable.

Examiner disagrees.

As seen in figure 1.4, the phrases in the NFL web page such as "Get in the Huddle- NFL LIVE CHAT!" or "Speak Your Mind in the NFL Fan Survey" in underline format are hyperlinks since a user has to click on said text to chat or do the survey. By analogy, to know who wins and how to win the contest, a user has to click on "Raider's Fan Wins Contest" which is also in underline format. Accordingly, a user has to click on "Cyberspace Showdown III" (in underlined format) to get more information about the cyberspace. Therefore, by common sense, without having to inspect the underlying HTML code, it was easy to see that all the text in underlined format on this web page are hyperlinks. *If these phrases were not hyperlinks, the NFL web page would be nonsense since the text "Cyberspace..", "Raider's Fan..", "Get in the Huddle...", and "Speak Your Mind..." are merely the topics of the web page. A user has no way to get any further detailed information of these topics, whereas the purpose of users in browsing the internet is for getting as much information as possible and the purpose of the web page author for posting as much information data as possible.*

Art Unit: 2178

Therefore, though the proof is just a static image in Brown, the proof provides sufficient grounds since the fact that the "Cyberspace Showdown III" and "Raider's Fan Wins Contest" in the underline format are hyperlinks is so well known and common sense that anybody can tell without the need of inspection of the underlying HTML code.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dolan et al. (US Pat No. 5,801,702, 9/1/98, filed 3/9/95).

Perkowitz et al. (US Pat No. 6,138,128, 10/24/00, filed 4/2/97).

Hobbs et al. (US Pat No. 5,987,454, 11/16/99, filed 6/9/97).

Fields et al. (US Pat No. 6,128,655, 10/3/00, filed 7/10/98).

King et al. (US Pat No. 6,353,839 B1, 3/5/02, filed 4/30/98).

Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Heidorn et al. (US Pat No. 6,089,081 B1, 8/1/00, filed 5/6/96).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is

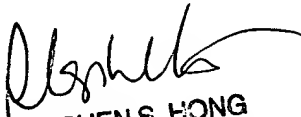
Art Unit: 2178

assigned are 703-746-7239 for regular communications and 707-746-7238 for

After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh  
10/9/02

  
STEPHEN S. HONG  
PRIMARY EXAMINER